

Remarks

The Examiner rejected claims 1, 4-10, 12-13, 15-19, and 21 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. The Examiner alleged that the limitation that “at least 20-fold increase in fluorescence intensity over that of the quenched dye groups” in claims 1, 12, and 21 is new matter. Applicants submit that this recitation is supported by the specification and is not new matter.

The specification states on page 14, lines 25-30 that “the present invention provides at least 10-, 20-, 30-fold and higher increases in fluorescence compared to conventional assay kits available commercially which only result in a 2-fold increase in fluorescence using a protease substrate.” If the two-fold increase of the commercially available kits is multiplied by at least a 10-fold increase in fluorescence compared to conventional assay kits, the present invention realizes a 20-fold increase in fluorescence using a protease substrate.

MPEP § 2163.02 provides that the “subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” In the claims of the present invention, the recitation of the at least 20-fold increase can be obtained readily by multiplication of two numbers that are disclosed to remove the need to compare the results to a commercially available assay kit. Thus, the specification supports a 20-fold increase. Likewise, the specification supports at least a 40-fold increase, and at least 60-fold increase.

Applicants respectfully request withdrawal of the rejection based on lack of written description.

Applicants have added new dependent claims that recite that the increase in fluorescence is 24 to 29-fold.

Applicants submit that pending claims 1, 4-10, 12-13, 15-24 are in condition for allowance and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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